

REMARKS

This application has been carefully reviewed in light of the Office Action dated September 16, 2003. Claims 1-5 remain pending in this application. Claim 1 is the independent claim. Favorable reconsideration is respectfully requested.

In response to the Office Action's objection to the disclosure for making reference to tables which were not included in the specification, Applicants respectfully submit that said tables have been requested from foreign counterparts and will be included in the specification in a later amendment. In response to the objection to the specification for failing to provide proper antecedent basis for Claim 3, Applicants note that support for Claim 3 exists at least one Page 2, lines 5-11.

On the merits, the Office Action rejected Claim 4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully believe that the amendments to Claim 4 adequately respond to the § 112, second paragraph rejection and request its withdrawal.

Further on the merits, the Office Action rejected Claims 1-5 under 35 U.S.C. § 103(a) as being unpatentable over Kawata (U.S. Patent No. 6,184,165; hereinafter "Kawata") or Sugimoto et al.

(U.S. Patent No. 6,458,734; hereinafter "Sugimoto") further in view of Fukuda et al. (U.S. Patent No. 5,827,792; hereinafter "Fukuda") or EP 0473347. Applicants respectfully traverse the § 103 rejection for at least the following reasons:

Applicants' Claim 1 recites: "A dielectric ceramic composite characterised by comprising (BaNdSm)TiO₃, ZnO, SiO₂, CuO, Al₂O₃, MgO, B₂O₃, Bi₂O₃ and either BaCO₃ or BaO."

As stated in the Office Action, Kawata and Sugimoto fail to recite or suggest teaching the presence of Bi₂O₃. The Office Action cites Fukuda and the EP reference to show Bi₂O₃. However, the references cannot be properly combined. M.P.E.P. § 706.02(j) states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The combinations of the references fail to provide the motivation to combine and reasonable expectation of success. Specifically, each of Kawata, Sugimoto, Fukuda and the EP reference require separate mass percentages for the composition of their respective

glass powders. No simple substitution of Bi₂O₃ can be made without significantly altering those exact mass percentages that affect the structure, material properties, and method of forming the dielectric ceramic. One of ordinary skill in the art at the time of the invention would fail to have the requisite motivation to combine the references without undue experimentation. Consequently, Claim 1 is believed patentable over the references for at least these reasons.

Further, mere possibilities do not constitute grounds by which an obviousness rejection can be maintained without improper hindsight by "use[ing] the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention," see *In Re Denis Rouffet*, 47 USPQ.2d 1453, 1457-58 (Fed. Cir. 1998). This improper hindsight indicates an improper means by which to reject a claim.

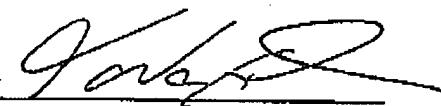
Applicants' Claim 1 is believed patentable over the prior art references, taken separately or in any proper combination, for at least these reasons.

Claims 2-5 depend from independent Claim 1 discussed above and are believed patentable for at least the same reasons. In addition, Applicants respectfully believe Claims 2-5 to be independently patentable and request separate consideration of each claim.

In view of the foregoing remarks, Applicants respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached by telephone at the number given below.

Respectfully submitted,

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